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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/290,363	04/12/1999	MARCUS PEINADO	MSFT-0035	9794
41505	7590	11/07/2005	EXAMINER	
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			NGUYEN, CUONG H	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/290,363	PEINADO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	CUONG H. NGUYEN	3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 October 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-14, 17-43, 46-67, 70-95, 98-117, 120-135 and 138-142 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-14, 17-43, 46-67, 70-95, 98-101, 103-117, 120-135 and 138-142 is/are allowed.
- 6) Claim(s) 102 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 April 1999 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

1. This Office Action is the answer to the letter of changing address received on 10/22/2004.

### Status of the claims

2. Claims 1-14, 17-43, 46-67, 70-95, 98-117, 120-135, 138-142 are pending at this time. Claims 15-16, 44-45, 68-69, 96-97, 118-119, 136-137 were canceled in a paper submitted on 2/20/2004.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 102 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **Claim 102 recites the limitation "The architecture of claim 96"; there is insufficient antecedent basis for this limitation in the claim because claim 96 was canceled.**

### *Allowable Subject Matter & Reasons for Allowance*

4. Independent claims 1 and 56 are patentable over the closest references of Krishnan, Stefik, Rabne et al., Downs et al., Clark, and Shear et al., because they do not anticipate nor fairly and reasonably teach an enforcement architecture for digital rights management, wherein the architecture enforce rights in protected digital content, comprising:
  - a license server for issuing digital license corresponding to and separate from said digital content wherein the content server distributes the digital content in an encrypted

form, and wherein the digital right management system includes a trusted black box for performing decryption and encryption functions.

5. Independent claim **30** is patentable over the closest references of Krishnan, Stefik, Rabne et al., Downs et al., Clark, and Shear et al., because they do not anticipate nor fairly and reasonably teach a method for implementing digital rights management, wherein the method enforces rights in protected digital content, comprising:

- issuing by a license server a digital license that is separate from said digital content; and distributing, by the content server, said digital content in an encrypted form, and employing a trusted black box in the digital rights management system to perform decryption and encryption functions.

6. Independent claim **83** is patentable over the closest references of Krishnan, Stefik, Rabne et al., Downs et al., Clark, and Shear et al., because they do not anticipate nor fairly and reasonably teach an enforcement architecture for digital rights management (DRM), wherein the architecture enforces rights in protected digital content, comprising:

- a content server distributes the digital content in an encrypted form, wherein the DRM system includes a trusted black box for performing decryption and encryption functions for such DRM system, wherein the black box includes a unique public/private key pair, and wherein a license server issues each digital license in response to a license request from the DRM system, the license including the black box public key, the license server encrypting said digital license according to the black box public key prior to issuance of such license, thereby binding such license to such black box.

7. Independent claim **106** is patentable over the closest references of Krishnan, Stefik, Rabne et al., Downs et al., Clark, and Shear et al., because they do not anticipate

nor fairly and reasonably teach a computer-readable medium having stored instructions for enforcing rights in protected digital content, comprising:

- receiving the digital content in an encrypted form, then performing decryption of the digital content by a trusted black box of the DRM system.

8. Independent claim 126 is patentable over the closest references of Krishnan, Stefik, Rabne et al., Downs et al., Clark, and Shear et al., because they do not anticipate nor fairly and reasonably teach a method for implementing digital rights management (DRM), wherein the method enforces rights in protected digital contend, comprising:

- employing a trusted black box in the DRM system to perform decryption and encryption functions, wherein said black box includes a public/private key pair, and wherein requesting the digital license comprises including in the request the black box public key, wherein the license server encrypts a portion of the digital license according to the black box public key prior to issuance of such license, thereby binding such license to such black box.

9. Claims 17-29, 31-43, 46-55, 57-67, 70-95, 98-101, 103-117, 120-135, and 138-142 are allowed because they are dependent on claims 30, 56, 83, 106, 126.

### *Conclusion*

10. Claims 1-14, 17-43, 46-67, 70-95, 98-117, 120-135, and 138-142 are patentable.

Claim 102 is rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 7:30 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CUONG H. NGUYEN  
Primary Examiner  
Art Unit 3661